

Remarks

Claims 1-19 are pending.

Amendments

The drawings have been placed in a more formal condition.

Claim 9 have been amended remove the term “and/or” to clarify that the two base parts, the coupling parts, or both are at least partially coated. Claims 10, 18, and 19 have been likewise amended to remove the term “and/or”.

No new matter has been added.

Objection to the Drawings

Applicant respectfully submits that the formal drawings in the replacement sheets are in compliance with all formality requirements and applicable rules. Thus, Applicant submits that the objection should be withdrawn.

Claim Rejection Under 35 U.S.C. § 112

Claims 9, 10, 18, and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejection is respectfully traversed.

Claims 9, 10, 18, and 19 have been amended to remove the objected to term “and/or.” Thus, Applicant submits that the pending claims are definite and clear. Withdrawal of the rejection is respectfully requested.

Claim Rejection Under 35 U.S.C. § 102

Claims 1-7, 9-16, 18, and 19 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2004/0243241 A1 to Istephanous et al. (“Istephanous”). The rejection is respectfully traversed.

Istephanous does not disclose all the elements of Applicant's claims. Istephanous discloses spinal implants which include upper portions 52, 102 and lower portions 54, 104. Paragraphs [0063] and [0073]. The upper portions 52, 102 include a projection and the lower portions 54, 104 include a trough 74 configured to receive the projection 70. Paragraphs [0065]-[0066]. The upper portions 52, 102 and the lower portions 54, 104 may comprise a metal matrix composite or a polymeric material. Paragraphs [0067]-[0068]. In one embodiment, the projection 70 is formed of a metal matrix composite. Paragraph [0065]. The trough 74 is formed of a metal matrix composite. Paragraph [0069]. Thus, if the upper portions 52, 102 and lower portions 54, 104, the projection 70, and the trough 74 are formed of the same material, then this material is a metal matrix composite.

In contrast, Applicant's claims require a base part and a coupling part formed in one piece, and made of a material selected from Polyetherketone (PEK), Polyetheretherketone (PEEK), Polyacryletherketone (PAEK), Polyetherketoneketone (PEKK), Polyetherketoneethketoneketone (PEKEKK) and Polyetherketoneetherketone (PEKEK). Though Istephanous may disclose an alternate embodiment in which the projection 70 (i.e., protuberance) comprises a polymer, this projection is *separable and non-integral* with the upper portion 52. Thus, Istephanous does not disclose or suggest a prosthesis part comprising a base part and a coupling part *formed in one piece* and made of a material specified by Applicant's claims.

Therefore, Istephanous does not anticipate Applicant's claims.

Claim Rejection Under 35 U.S.C. § 103

Claims 8 and 17 are rejected under 35 U.S.C. § 103(a) as obvious over Istephanous in view of U.S. Patent No. 6,322,588 B1 to Ogle et al. (“Ogle”). The rejection is respectfully traversed.

As discussed above, Istephanous does not disclose or suggest a base part and a coupling part formed in one piece, and made of a material selected from polyetherketone (PEK), polyetheretherketone (PEEK), polyacryletherketone (PAEK), polyetherketoneketone (PEKK), polyetherketoneethketoneketone (PEKEKK) and polyetherketoneetherketone (PEKEK). Nothing in Ogle, alone or in combination with Istephanous, can be construed to supplement this deficiency.

Moreover, Istephanous teaches away from modification of the implant disclosed therein so that a base part and a coupling part formed in one piece and made of a polymer material, as required by Applicant’s claims. “A prior reference must be considered in its entirety, i.e. as a whole, **including portions that would lead away from the claimed invention.**” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); MPEP § 2141.02 [VI] (emphasis added). In particular, Istephanous teaches that the implants comprising the metal matrix material exhibit enhanced wear characteristics. (Abstract, Paragraph [0069]). Thus, one of ordinary skill in the art would not have had a reason to, and would have been hesitant to, modify Istephanous to derive Applicant’s claimed devices in the precise fashion claimed.

Thus, a *prima facie* case of obvious has not been established and Applicant’s claims are novel and nonobvious.

Serial No. 10/596,158
Amendment and Response to
Non-Final Office Action mailed March 17, 2009
Page 10 of 10

CONCLUSION

The foregoing is believed to be a full response to the Office Action. In the event that any additional fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 19-5029. If there are any issues that can be resolved by a telephone conference or an Examiner's amendment, the Examiner is invited to call the undersigned attorney at (404) 853-8036.

Respectfully submitted,



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